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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/392,678	09/09/1999	STEVEN M. DRUCKER	1026-012/MMM	1607

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EXAMINER

JONES, HUGH M

ART UNIT

PAPER NUMBER

2123

DATE MAILED: 01/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/392,678

Applicant(s)  
Drucker et al.

Examiner  
Hugh Jones

Art Unit  
2123



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Sep 9, 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 5 6) ☐ Other:

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### **DETAILED ACTION**

1. Claims 1-21 of U.S. Application 09/392,678 filed 9/9/1999 are pending.

#### **Priority**

2. Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged.

However, the provisional application upon which priority is claimed fails to provide adequate support under 35 U.S.C. 112 for claims 1-21 of this application. The instant application contains matter not supported by the provisional application, namely, figures 5-7 and all matter directed at the "Prisoner's Dilemma" embodiment.

#### **Information Disclosure Statement**

3. The Examiner notes that the *Applicants* have published academic papers on related topics which are relevant to the examination of the instant application - none of which has been cited in the IDS. In particular, "The Commons: A toolbox for the qualitative analysis of factors in the success or failure of electronic societies" by Berman et al. has been obtained. The Examiner requests that Applicants indicate the date of publication of said document. The Examiner also queries whether there are any other published documents by Applicants. As these references are not readily available to the Examiner, the applicant should provide the office with copies of the reference in any response to this action. Applicant is reminded of their duty to disclose all information material to the patentability of the application as per 37 C.F.R. 1.56.

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**Claim Rejections - 35 USC § 101**

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. **Claims 1-7, 15-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.** These claims appear to recite a computer program product. It should be noted that code (i.e., a computer software program) does not do anything per se. Instead, it is the code stored on a computer that, *when executed*, instructs the computer to perform various functions. The following claim is a generic example of a proper computer program product claim;

A computer program product embodied on a computer-readable medium and comprising code that, when executed, causes a computer to perform the following:

Function A

Function B

Function C, etc...

**Claim Rejections - 35 USC § 112**

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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7. **Claims 1-21 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.**The instant application contains matter not supported by the provisional application, namely, figures 5-7 and all matter directed at the "Prisoner's Dilemma" embodiment.

8. **Claims 1-21 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.**The instant application contains matter not supported by the provisional application, namely, figures 5-7 and all matter directed at the "Prisoner's Dilemma" embodiment.

**Claim Interpretation**

9. The broadest, most reasonable interpretation has been provided to the claims. The invention appears to be an interactive "Prisoner's Dilemma" game played over the internet.

**Claim Rejections - 35 USC § 103**

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 148 USPQ 459, that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or

unobviousness.

12. **Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over (Groblenik et al. *or* "Noise-IPD Game Contest" *or* Brown) in view of (Honda et al. *or* Saar).**

13. Groblenik et al. disclose "Strategic interaction on the internet," including playing Social Dilemma games on the internet (sections I-II).

14. "Noise-IPD Game Contest" disclose rules for a contest to develop interactive social dilemma games, including "Prisoner's Dilemma). See pages 1-6.

15. Brown disclose a multi-player on-line interactive gaming environment including "Prisoner's Dilemma". See fig. 6-7; col. 5, line 61 to col. 8, line 10.

16. Groblenik et al. *or* "Noise-IPD Game Contest" *or* Brown teach all limitations and features as discussed, but do not disclose playing the game via a multi-user virtual society.

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17. Honda et al. disclose "Virtual Society: extending the WWW to support a multi-user interactive shared 3D environment," including fig. 1 (server-client relation between WWW and Virtual Society); section 3 (Virtual Society architecture); and section 4 (protocol).

18. Saar disclose "VIRTUS: a collaborative multi-user platform," including objects and collaborative virtual environment and distributed virtual environments. See abstract; section 2.1 (application to interactive gaming); section 4 (VIRTUS architecture);

19. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of *Honda et al.* or *Saar* into the teachings of Groblenik et al. or "Noise-IPD Game Contest" or Brown for the following reasons. Honda et al. disclose that a virtual society model is a natural extension of the WWW and VRML browsers and that users and service providers will benefit from the more natural interaction (pg. 109, Honda et al.). Saar discloses that the shared multi-user worlds would provide added benefits (collaborative pursuits) over the solitary WWW world (page 141).

### Conclusion

20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Berman et al. (Applicants): "The Commons: a toolkit for the quantitative analysis of factors in the success or failure of electronic societies" - date unknown.

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- "The Prisoner's Dilemma": printout from website (<http://pespmc.ac.be/PRISDIL.html>),  
1995; pp. 1-3.

**21. Any inquiry concerning this communication or earlier communications from the examiner should be:**

**directed to:**

Dr. Hugh Jones telephone number (703) 305-0023, Monday-Thursday 0830 to 0700 ET, *or* the examiner's supervisor, Kevin Teska, telephone number (703) 305-9704. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, telephone number (703) 305-3900.

**mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

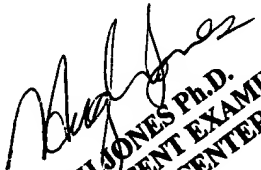
**or faxed to:**

(703) 308-9051 (for formal communications intended for entry)  
*or* (703) 308-1396 (for informal or draft communications, please label "*PROPOSED*" or "*DRAFT*").

Dr. Hugh Jones

Primary Patent Examiner

January 1, 2003

  
HUGH JONES Ph.D.  
PRIMARY PATENT EXAMINER  
TECHNOLOGY CENTER 2100